

ESTTA Tracking number: **ESTTA581333**

Filing date: **01/11/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	PaulFerrara
Granted to Date of previous extension	01/15/2014
Address	2 Turtle Hollow Drive Manalapan, NJ 07726 UNITED STATES
Correspondence information	Bruce T. Margulies Attorney of Record Neifeld IP Law, PC 4813-B Eisenhower Ave. Alexandria, VA 22304 UNITED STATES bmargulies@neifeld.com Phone:7034150012

### Applicant Information

Application No	85901878	Publication date	09/17/2013
Opposition Filing Date	01/11/2014	Opposition Period Ends	01/15/2014
Applicant	Laracuenta, Juliette 4th Floor / Loft Space C-404 Hoboken, NJ 07030 USX		

### Goods/Services Affected by Opposition


Class 003. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Adhesives for false eyelashes, hair andnails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial make-up; Foundation make-up; Lipstick

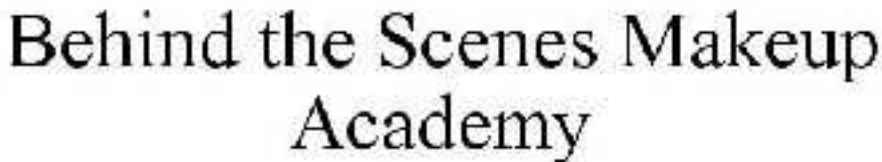
### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Genericness	Trademark Act section 23

### Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85563508	Application Date	03/07/2012
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	FERRARA MAKEUP ACADEMY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Educational services in the nature of beauty schools		

U.S. Registration No.	4379779	Application Date	12/20/2012
Registration Date	08/06/2013	Foreign Priority Date	NONE
Word Mark	BEHIND THE SCENES MAKEUP ACADEMY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2013/02/27 First Use In Commerce: 2013/02/27 Educational services in the nature of beauty schools; education and training, namely, conducting classes, workshops and seminars and providing educational demonstrations and training all in the field of beauty and makeup applications including cosmetics and special effects		

Related Proceedings	Petition to Cancel 92058064 for Reg. No. 4423339
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Attachments	85563508#TMSN.jpeg( bytes ) 85808483#TMSN.jpeg( bytes ) NoticeOfOpposition_1-10-2014c.pdf(106116 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/BTM/
Name	Bruce T. Margulies
Date	01/11/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application No. 85/901,878

Opposition No: Filed herewith

For the mark “ARTIST MAKEUP ACADEMY”

Paul Ferrara,

Opposer

v.

Juliette Laracuate,

Applicant

NOTICE OF OPPOSITION

Paul Ferrara, with an address at 2 Turtle Hollow Drive, Manalapan, NJ 07726, United States (“Opposer”) believes he will be damaged by registration of the mark shown in Application No. 85/901,878 for “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick in international class 003” (“the Application” and/or “Applicant’s Mark”), filed by Juliette Laracuate, 4th Floor / Loft Space C-404 720 Monroe Street Hoboken NEW JERSEY 07030, (“Applicant”) and opposes the same.

The required fee for the filing of this Notice of Opposition is submitted herewith. If any additional fees are due, please charge said fees to Deposit Account No: 50-2106.

The grounds for the Opposition are as follows:

**COUNT 1 - Likelihood to Cause Confusion, cause mistake, or to deceive; Trademark Act  
Section 2(d), 15 USC Section 1052(d)**

1. Opposer filed Application No. 85/563,508 on March 7, 2012 for “FERRARA MAKEUP ACADEMY” for “Educational services in the nature of beauty schools, in class 041”.
2. Opposer filed Application No. 85/808,483 on December 20, 2012 for “BEHIND THE SCENES MAKEUP ACADEMY” for “Educational services in the nature of beauty schools; education and training, namely, conducting classes, workshops and seminars and providing educational demonstrations and training all in the field of beauty and makeup applications including cosmetics and special effects, in class 041”.
4. Applicant filed Application No. 85/901,878 on April 11, 2013, with a basis of “intent to use”, for “ARTIST MAKEUP ACADEMY” for “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick, in class 003”. A true copy of Application No. 85/901,878 is included as Attachment 1.
5. Opposer’s Application No. 85/563,508 for “FERRARA MAKEUP ACADEMY” has priority over Applicant’s Application No. 85/901,878 for “ARTIST MAKEUP ACADEMY”.
6. Opposer’s Application No. 85/808,483 for “BEHIND THE SCENES MAKEUP ACADEMY” has priority over Applicant’s Application No. 85/901,878 for “ARTIST MAKEUP ACADEMY”.
7. Applicant is entitled to protection against the registration of a mark similar to Application

No. 85/563,508 for “FERRARA MAKEUP ACADEMY” for “Educational services in the nature of beauty schools, in class 041” on products/services that might reasonably be expected to be produced by him in the normal expansion of his business.

8. Applicant is entitled to protection against the registration of a mark similar to Application No. 85/808,483 for “BEHIND THE SCENES MAKEUP ACADEMY” for “Educational services in the nature of beauty schools; education and training, namely, conducting classes, workshops and seminars and providing educational demonstrations and training all in the field of beauty and makeup applications including cosmetics and special effects, in class 041” on products/services that might reasonably be expected to be produced by him in the normal expansion of his business.

9. Applicant’s goods “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick, in class 003” fall within the normal fields of expansion for Opposer’s Application No. 85/563,508 for “FERRARA MAKEUP ACADEMY” for “Educational services in the nature of beauty schools, in class 041”.

10. Applicant’s goods “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick, in class 003” fall within the normal fields of expansion for Opposer’s Application No. Application No. 85/808,483 for “BEHIND THE SCENES MAKEUP ACADEMY” for “Educational services in the nature of beauty schools; education and training, namely, conducting classes, workshops and seminars and providing educational demonstrations and training all in the field of beauty and makeup applications including cosmetics and special

effects, in class 041".

11. Applicant's mark for "ARTIST MAKEUP ACADEMY" so resembles Opposer's mark "FERRARA MAKEUP ACADEMY", as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive.

12. Applicant's mark for "ARTIST MAKEUP ACADEMY" so resembles Opposer's mark "BEHIND THE SCENES MAKEUP ACADEMY", as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive.

**COUNT 2 - Merely Descriptive: Trademark Act Section 2(d), 15 USC Section 1052(e)**

13. Opposer realleges and incorporates by reference herein all paragraphs of this Complaint as if fully repeated herein.

14. Applicant's Mark describes an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant's specified goods or services, namely to describe a type of service provided by Applicant, namely a training facility for makeup artists; and by extension, Applicant's Mark's claimed goods: "Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick" commonly used by Makeup Artists.

15. Applicant's Mark immediately conveys knowledge of a quality, feature, function, or characteristic of Applicant's goods or services, namely to describe a type of service provided by Applicant, namely a training facility for makeup artists; and by extension, Applicant's Mark's

claimed goods: “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick” commonly used by Makeup Artists.

16. On July 31, 2013, Applicant authorized an Examiner’s Amendment, disclaiming “MAKEUP ACADEMY” in Application No. 85/901,878. A true copy of said Examiner’s Amendment is included as Attachment 2.

17. Applicant’s Mark, when used on or in connection with the goods or services of Applicant, is merely descriptive.

**COUNT 3 - Generic: 15 USC Section 1064(3)**

18. Opposer realleges and incorporates by reference herein all paragraphs of this Complaint as if fully repeated herein.

19. The term “Artist Makeup Academy” is widely used to describe a type of service provided by Applicant, namely a training facility for makeup artists; and by extension, Applicant’s Mark’s claimed goods: “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick” commonly used by Makeup Artists.

20. The term “Artist Makeup Academy” is generic, in that it is widely used to describe a type of service provided by Applicant, namely a training facility for makeup artists; and by extension, Applicant’s Mark’s claimed goods: “Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial makeup; Foundation make-up; Lipstick” commonly used by Makeup Artists.



21. “Artist Makeup Academy” is not capable of distinguishing Applicant’s goods.
22. Registration of Applicant’s Mark would harm competitors of Applicant who need the terms “Makeup Academy” and “Artist” to refer to their goods/services.
23. Applicant’s Mark is generic.

WHEREFORE, Opposer's Mark has priority over Applicant's Mark.

WHEREFORE, Applicant's mark so resembles Opposer's Marks, as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive.

WHEREFORE, Applicant's Mark is merely deceptive.

WHEREFORE, Applicant's Mark is generic.

WHEREFORE, Opposer prays that the Opposition be sustained and that Application No. 85/901,878 be withdrawn.

Respectfully submitted,

/BruceMargulies/

Bruce T. Margulies

Neifeld IP Law, PC

4813-B Eisenhower Ave.

Alexandria, VA 22304

(703) 415-0012 ext. 102

bmargulies@neifeld.com

Attorney of Record for Opposer

1/11/2014

Date

Certificate of Service

I certify that on January <sup>11</sup>~~10~~, 2014, I caused a copy of the foregoing Notice of Opposition to be transmitted by First Class U.S. Mail to Applicant at the Applicant's correspondence address of record in the Office:

JULIETTE LARACUENTE  
720 MONROE ST  
HOBOKEN, NEW JERSEY 07030-6315

1/11/2014  
Date

/BruceMargulies/  
Bruce T. Margulies

Attachment 1

# Trademark/Service Mark Application, Principal Register

## TEAS Plus Application

Serial Number: 85901878

Filing Date: 04/11/2013

**NOTE:** Data fields with the \* are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
<b>TEAS Plus</b>	<b>YES</b>
<b>MARK INFORMATION</b>	
*MARK	<a href="#">Artist Makeup Academy</a>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	Artist Makeup Academy
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>REGISTER</b>	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	Laracuenta, Juliette
INTERNAL ADDRESS	4th Floor / Loft Space C-404
*STREET	720 Monroe Street
*CITY	Hoboken
*STATE (Required for U.S. applicants)	New Jersey
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	07030
PHONE	2012225722

<b>FAX</b>	2012225770
<b>EMAIL ADDRESS</b>	info@gseafg.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>WEBSITE ADDRESS</b>	http://www.artistmakeupacademy.com
<b>LEGAL ENTITY INFORMATION</b>	
<b>* TYPE</b>	INDIVIDUAL
<b>* COUNTRY OF CITIZENSHIP</b>	United States
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
<b>* INTERNATIONAL CLASS</b>	003
<b>* IDENTIFICATION</b>	Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial make-up; Foundation make-up; Lipstick
<b>* FILING BASIS</b>	SECTION 1(b)
<b>ADDITIONAL STATEMENTS INFORMATION</b>	
<b>* TRANSLATION</b> (if applicable)	
<b>* TRANSLITERATION</b> (if applicable)	
<b>* CLAIMED PRIOR REGISTRATION</b> (if applicable)	
<b>* CONSENT (NAME/LIKENESS)</b> (if applicable)	
<b>* CONCURRENT USE CLAIM</b> (if applicable)	
<b>CORRESPONDENCE INFORMATION</b>	
<b>* NAME</b>	Laracuenta, Juliette
<b>DOCKET/REFERENCE NUMBER</b>	IC003-AMA-T
<b>INTERNAL ADDRESS</b>	4th Floor / Loft Space C-404
<b>* STREET</b>	720 Monroe Street
<b>* CITY</b>	Hoboken
<b>* STATE</b> (Required for U.S. applicants)	New Jersey
<b>* COUNTRY</b>	United States
<b>* ZIP/POSTAL CODE</b>	07030

<b>PHONE</b>	2012225722
<b>FAX</b>	2012225770
<b>* EMAIL ADDRESS</b>	info@gseafg.com
<b>* AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>FEE INFORMATION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>FEE PER CLASS</b>	275
<b>* TOTAL FEE PAID</b>	275
<b>SIGNATURE INFORMATION</b>	
<b>* SIGNATURE</b>	/Juliette Laracuenta/
<b>* SIGNATORY'S NAME</b>	Juliette Laracuenta
<b>* SIGNATORY'S POSITION</b>	President/CEO
<b>SIGNATORY'S PHONE NUMBER</b>	2012225722
<b>* DATE SIGNED</b>	04/11/2013

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## **Trademark/Service Mark Application, Principal Register**

### **TEAS Plus Application**

**Serial Number: 85901878**

**Filing Date: 04/11/2013**

#### **To the Commissioner for Trademarks:**

**MARK:** Artist Makeup Academy (Standard Characters, see [mark](#))

The literal element of the mark consists of Artist Makeup Academy.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Juliette Laracuate, a citizen of United States, having an address of  
4th Floor / Loft Space C-404,  
720 Monroe Street  
Hoboken, New Jersey 07030  
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

#### **For specific filing basis information for each item, you must view the display within the Input Table.**

International Class 003: Adhesives for false eyelashes, hair and nails; Cosmetics, namely, lip primer; Eye shadow; Face powder; Facial concealer; Facial make-up; Foundation make-up; Lipstick  
Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

For informational purposes only, applicant's website address is: <http://www.artistmakeupacademy.com>

The applicant's current Correspondence Information:

Laracuate, Juliette  
4th Floor / Loft Space C-404  
720 Monroe Street  
Hoboken, New Jersey 07030  
2012225722(phone)  
2012225770(fax)  
[info@gseafg.com](mailto:info@gseafg.com) (authorized)

The docket/reference number is IC003-AMA-T.

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1

class(es).

### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Juliette Laracuenta/ Date Signed: 04/11/2013

Signatory's Name: Juliette Laracuenta

Signatory's Position: President/CEO

RAM Sale Number: 85901878

RAM Accounting Date: 04/12/2013

Serial Number: 85901878

Internet Transmission Date: Thu Apr 11 17:28:58 EDT 2013

TEAS Stamp: USPTO/FTK-38.108.124.162-201304111728589

05924-85901878-50045b159cab542383a38bf2a

2bf115014f644f7cc741b66a12ed1e72b47bc855

f-CC-4635-20130411171658024139



# Artist Makeup Academy

Attachment 2

**To:** Laracuate, Juliette ([info@gseafg.com](mailto:info@gseafg.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85901878 - ARTIST MAKEUP ACADEMY - IC003-AMA-T  
**Sent:** 7/31/2013 5:19:24 PM  
**Sent As:** ECOM113@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85901878

**MARK:** ARTIST MAKEUP ACADEMY

**\*85901878**

**CORRESPONDENT ADDRESS:**

LARACUENTE, JULIETTE  
720 MONROE ST  
HOBOKEN, NJ 07030-6315

**GENERAL TRADEMARK**  
<http://www.uspto.gov/tra>

**APPLICANT:** Laracuate, Juliette

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

IC003-AMA-T

**CORRESPONDENT E-MAIL ADDRESS:**

[info@gseafg.com](mailto:info@gseafg.com)

**EXAMINER'S AMENDMENT**

**ISSUE/MAILING DATE:** 7/31/2013

**DATABASE SEARCH:** The trademark examining attorney has searched the USPTO's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

**APPLICATION HAS BEEN AMENDED:** In accordance with the authorization granted by Juliette Laracuate on July 30, 2013, the trademark examining attorney has amended the application as indicated below. Please advise the undersigned immediately of any objections. Otherwise, no response is necessary. TMEP §707. Any amendments to the identification of goods may clarify or limit the goods, but may not add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*

The following statement is added to the record:

**No claim is made to the exclusive right to use “MAKEUP ACADEMY” apart from the mark as shown.**

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

After issuance of an examiner’s amendment, the trademark examining attorney will usually approve the mark for publication in the *Official Gazette*, a weekly publication of the USPTO. The USPTO will then send a “Notice of Publication” to the applicant specifying the date of publication.

The purpose of publishing applicant’s mark in the *Official Gazette* is to provide an opportunity to third parties who believe they may be damaged by registration of applicant’s mark to oppose its registration within thirty (30) days from the publication date. An “opposition” is similar to a federal court proceeding, but this proceeding is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal of administrative judges who issue decisions on such matters. If an opposition proceeding is instituted to oppose registration of applicant’s mark, applicant will receive notice. In such cases, due to the complexity of such matters, applicant may wish to hire an attorney.

If the mark is published based upon the actual use of the mark in commerce, or based on a foreign registration, and no party opposes its registration, the USPTO will normally register the mark and issue a registration certificate within approximately twelve (12) weeks after the date the mark was published.

If the mark is published based upon the applicant’s bona fide intention to use the mark in commerce, the USPTO will issue a “Notice of Allowance” within approximately eight (8) weeks after the date the mark was published, if no party files an opposition. Applicant then has six (6) months from the date of the Notice of Allowance to timely file a “Statement of Use” or to file a request for a six-month “Extension of Time to file a Statement of Use.” Extension requests are granted for six-month increments and a maximum of five extension requests can be filed after the issuance of the Notice of Allowance. If not filed within the six months after the Notice of Allowance issued, a Statement of Use must be filed within the time period of a previously granted extension of time.

Forms for extension requests and Statements of Use are available online at [http://www.uspto.gov/trademarks/teas/intent\\_to\\_use.jsp](http://www.uspto.gov/trademarks/teas/intent_to_use.jsp). For more information about the **additional requirements for intent to use applications**, visit the USPTO website. Only after a Statement of Use is approved by the trademark examining attorney will the USPTO issue a registration certificate.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney.

/Marynelle W. Wilson/  
Examining Attorney  
Law Office 113  
Phone: 571-272-7978  
Email: marynelle.wilson@uspto.gov

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.